

PATENT COOPERATION TREATY

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From the
INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY

PCT

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2005 -02- 23

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NOTIFICATION OF TRANSMITTAL OF
THE INTERNATIONAL PRELIMINARY
EXAMINATION REPORT

(PCT Rule 71.1)

Date of mailing

(day/month/year)

16.02.2005

Applicant's or agent's file reference
PA133634/PCT

IMPORTANT NOTIFICATION

International application No.
PCT/B 03/03892

International filing date (day/month/year)
12.09.2003

Priority date (day/month/year)
30.10.2002

Applicant
ELEMENT SIX (PROPRIETARY) LIMITED et al.

1. The applicant is hereby notified that this International Preliminary Examining Authority transmits herewith the international preliminary examination report and its annexes, if any, established on the international application.

2. A copy of the report and its annexes, if any, is being transmitted to the International Bureau for communication to all the elected Offices.

3. Where required by any of the elected Offices, the International Bureau will prepare an English translation of the report (but not of any annexes) and will transmit such translation to those Offices.

4. REMINDER

The applicant must enter the national phase before each elected Office by performing certain acts (filing translations and paying national fees) within 30 months from the priority date (or later in some Offices) (Article 39(1)) (see also the reminder sent by the International Bureau with Form PCT/IB/301).

Where a translation of the international application must be furnished to an elected Office, that translation must contain a translation of any annexes to the international preliminary examination report. It is the applicant's responsibility to prepare and furnish such translation directly to each elected Office concerned.

For further details on the applicable time limits and requirements of the elected Offices, see Volume II of the PCT Applicant's Guide.

The applicant's attention is drawn to Article 33(5), which provides that the criteria of novelty, inventive step and industrial applicability described in Article 33(2) to (4) merely serve the purposes of international preliminary examination and that "any Contracting State may apply additional or different criteria for the purposes of deciding whether, in that State, the claimed inventions is patentable or not" (see also Article 27(5)). Such additional criteria may relate, for example, to exemptions from patentability, requirements for enabling disclosure, clarity and support for the claims.

Name and mailing address of the international
preliminary examining authority:



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PATENT COOPERATION TREATY

PCT

INTERNATIONAL PRELIMINARY EXAMINATION REPORT (PCT Article 36 and Rule 70)

Applicant's or agent's file reference PA133634/PCT	FOR FURTHER ACTION		See Notification of Transmittal of International Preliminary Examination Report (Form PCT/PEA/416)
International application No. PCT/B 03/03892	International filing date (<i>day/month/year</i>) 12.09.2003	Priority date (<i>day/month/year</i>) 30.10.2002	
International Patent Classification (IPC) or both national classification and IPC E21B10/56			
Applicant ELEMENT SIX (PROPRIETARY) LIMITED et al.			

1. This international preliminary examination report has been prepared by this International Preliminary Examining Authority and is transmitted to the applicant according to Article 36.

2. This REPORT consists of a total of 5 sheets, including this cover sheet.

☐ This report is also accompanied by ANNEXES, i.e. sheets of the description, claims and/or drawings which have been amended and are the basis for this report and/or sheets containing rectifications made before this Authority (see Rule 70.16 and Section 607 of the Administrative Instructions under the PCT).

These annexes consist of a total of sheets.

3. This report contains indications relating to the following items:

I ☒ Basis of the opinion

II ☐ Priority

III ☐ Non-establishment of opinion with regard to novelty, inventive step and industrial applicability

IV ☐ Lack of unity of invention

V ☒ Reasoned statement under Rule 66.2(a)(ii) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

VI ☐ Certain documents cited

VII ☐ Certain defects in the international application

VIII ☐ Certain observations on the international application

Date of submission of the demand 24.05.2004	Date of completion of this report 16.02.2005
Name and mailing address of the international preliminary examining authority: <div style="display: flex; align-items: center;"> <div> European Patent Office D-80298 Munich Tel. +49 89 2399 - 0 Tx: 523656 epmu d Fax: +49 89 2399 - 4465 </div> </div>	Authorized Officer Georgescu, M Telephone No. +49 89 2399-7502



INTERNATIONAL PRELIMINARY
EXAMINATION REPORT

International application No. PCT/IB 03/03892

I. Basis of the report

1. With regard to the **elements** of the international application (*Replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to this report since they do not contain amendments (Rules 70.16 and 70.17))*):

Description, Pages

1-9 as originally filed

Claims, Numbers

1-14 as originally filed

Drawings, Sheets

1/2-2/2 as originally filed

2. With regard to the **language**, all the elements marked above were available or furnished to this Authority in the language in which the international application was filed, unless otherwise indicated under this item.

These elements were available or furnished to this Authority in the following language: , which is:

- ☐ the language of a translation furnished for the purposes of the international search (under Rule 23.1(b)).
- ☐ the language of publication of the international application (under Rule 48.3(b)).
- ☐ the language of a translation furnished for the purposes of international preliminary examination (under Rule 55.2 and/or 55.3).
3. With regard to any **nucleotide and/or amino acid sequence** disclosed in the international application, the international preliminary examination was carried out on the basis of the sequence listing:
- ☐ contained in the international application in written form.
- ☐ filed together with the international application in computer readable form.
- ☐ furnished subsequently to this Authority in written form.
- ☐ furnished subsequently to this Authority in computer readable form.
- ☐ The statement that the subsequently furnished written sequence listing does not go beyond the disclosure in the international application as filed has been furnished.
- ☐ The statement that the information recorded in computer readable form is identical to the written sequence listing has been furnished.
4. The amendments have resulted in the cancellation of:
- ☐ the description, pages:
- ☐ the claims, Nos.:
- ☐ the drawings, sheets:

**INTERNATIONAL PRELIMINARY
EXAMINATION REPORT**

International application No. **PCT/B 03/03892**

5. ☐ This report has been established as if (some of) the amendments had not been made, since they have been considered to go beyond the disclosure as filed (Rule 70.2(c)).

(Any replacement sheet containing such amendments must be referred to under item 1 and annexed to this report.)

6. Additional observations, if necessary:

V. Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. Statement

Novelty (N)	Yes: Claims	8, 9
	No: Claims	1-7, 10-14
Inventive step (IS)	Yes: Claims	8
	No: Claims	1-7, 9-14
Industrial applicability (IA)	Yes: Claims	1-14
	No: Claims	

2. Citations and explanations

see separate sheet

**INTERNATIONAL PRELIMINARY
EXAMINATION REPORT - SEPARATE SHEET**

International application No. PCT/IB 03/03892

Reference is made to the following documents:

D1: US 5 979 571 A
D2: US 2001/0035302 A1
D3: EP 0 462 944 A
D4: US 6 601 662 A

V - Reasoned statement under Rule 66.2 (a)(ii)

V-1 Claims 1 and 12

D1, which is considered as the closest prior art, describes a tool insert having the features described in claim 1 (see in particular fig. 10, 11 and 12 with ultra-hard material 24, protective layer 30, and used for milling and drilling column 5, lines 20-23).

The features of claim 12 are also disclosed by D1 as a "kicking off" process (25-30) consists of method steps as described in claim 12.

The subject-matter of claims 1 and 12 is therefore not new and the claims do not meet the novelty requirement of Art. 33(2)PCT.

V-2 Claims 2 to 7 and 10 to 14

The features of claims 2 to 7 and 10 to 14 are also known from D1 (see indications in the Search Report).

Therefore, also claims 2 to 7 and 10 to 14 do not meet the novelty requirement of Art. 33(2)PCT.

V-3 Claim 8

The feature of claim 8 does not appear to be disclosed or suggested by the prior art documents and can be seen as solving the problem of simplifying the production process of the substrate.

V-4 Claim 9

The feature of claim 9 is merely a normal design possibility suggested also by D3 or D4.

Therefore, claim 9 does not meet the requirement for inventive step of Art. 33(3) PCT.

The following objections are raised:

- a. The independent claims are not properly cast in the two part form, with those features which in combination are part of the closest prior art (D1) being placed in the preamble, contrary to the requirements of Rule 6.3(b) PCT.
- b. The features of the claims are not provided with reference signs placed in parentheses (Rule 6.2(b) PCT).
- c. Contrary to the requirements of Rule 5.1(a)(ii)PCT, the relevant background art disclosed in documents D1, D2 is not mentioned in the description, nor are these documents identified therein.